

Docket No. 4126-4012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Rinehart et al.

Group Art Unit: 1614

Serial No.: 10/693,174

Examiner: Cook, Rebecca

Filed: November 4, 2004

For: SPISULOSINE COMPOUNDS

**EXPRESS MAIL CERTIFICATE**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Express Mail Label No.: EV 498 832 165 US

Date of Deposit: November 4, 2004

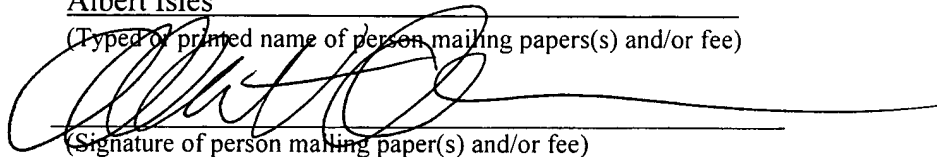
I hereby certify that the following attached paper(s) and/or fee

1. Response to Restriction Requirement (2 pages + duplicate page)
2. Return-Receipt Postcard

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Albert Isles

(Typed or printed name of person mailing papers(s) and/or fee)



(Signature of person mailing paper(s) and/or fee)

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 Telephone  
(212) 415-8701 Facsimile



11-08-04

If W

Docket No. 4126-4012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Kenneth L. Rinehart et al

Group Art Unit: 1614

Serial No.: 10/693,174

Examiner: Cook, Rebecca

Filed: 10/23/2003

For: Spisulosine Compounds

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the Restriction Requirement dated October 4, 2004, Applicant respectfully requests consideration of the following remarks.

Claims 19-38 are pending. Applicants elect Group I (claims 19-35) with traverse. With respect to the requirement to "elect a single disclosed species of method of use, such as treating cancer," (Office Action, page 2) for claims 26-33, Applicants elect claim 26, directed to a method of treating cancer. Applicants reserve the right to prosecute the subject matter of any non-elected claim in one or more continuation, continuation-in-part, or divisional applications.

**TRAVERSAL**

Applicants response to the Restriction/Election of Species Requirement is made with traverse. The requirement for restriction between Groups I-II is traversed because the Examiner has failed to show that a serious burden exists in examining the full scope of the invention as claimed (see MPEP § 802). As noted in the MPEP, "If the search and examination of an entire

application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (see MPEP 803). The MPEP expressly states that "where only generic claims are presented, no restriction can be required except in those applications where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary." See MPEP § 808.01(a) and 809.02(d). The Examiner has failed to show that a serious burden exists. Therefore, the restriction requirement is improper. Further, the restriction requirement was improper as it was directed to Group I (claims 19-35) and Group II (claims 37-38), while omitting claim 36. Applicants respectfully request clarification of the status of claim 36.

Applicants respectfully request withdrawal of the restriction requirement.

#### **AUTHORIZATION**

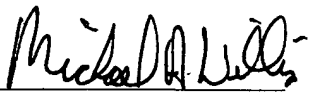
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 4126-4012. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4126-4012. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: November 4, 2004

By:

  
Kenneth H. Sonnenfeld / Michael A. Willis  
Reg. No. 33,285 / Reg. No. 53,913

**Correspondence Address:**

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 Telephone  
(212) 415-8701 Facsimile